

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Steelberg et al.	Art Unit :	2617
Patent No. :	7,460,863	Examiner :	Sharad K. Rampuria
Issue Date :	December 2, 2008	Conf. No. :	8212
Serial No. :	10/086,193		
Filed :	February 27, 2002		
Title :	METHOD AND APPARATUS USING GEOGRAPHICAL POSITION TO PROVIDE AUTHENTICATED, SECURE, RADIO FREQUENCY COMMUNICATION BETWEEN A GAMING HOST AND A REMOTE GAMING DEVICE		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 27 to 500 days, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under

35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before April 27, 2003 (the date that is fourteen months after February 27, 2002, the date on which the application was filed). The PTO mailed the first non-final Office Action on September 8, 2004, thereby according a PTO Delay of 500 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from April 28, 2003 (the day after the date that is fourteen months after the date on which the application was filed), to September 8, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before June 9, 2005 (the date that is four months after February 8, 2005, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on June 9, 2005, thereby according a PTO Delay of 1 day. Patentee does not dispute the PTO’s calculation for this “A Delay” for June 9, 2005 (the day after the date that is four months after the date on which a response to Office Action was filed). See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 501 days (i.e., the sum of 500 days and 1 day).

“B Delay”

The period beginning on February 28, 2005 (the day after the date that is three years after the date on which the application was filed), and ending December 2, 2008 (the date the patent was issued), is 1,374 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination (“RCE”) was filed and ending on the date the patent

was issued. In the present application, the earliest RCE was filed on June 16, 2006, and the patent issued on December 2, 2008, which resulted in a 900 day period that must also be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

“B Delay” for this patent is therefore calculated as 1,374 days minus 900 days, for a total of 474 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 474 days.

Overlap of “A Delay” and “B Delay”

The “A Delay” and the “B Delay” overlap (i.e., occur on the same calendar day) for a total of 1 day, on June 9, 2005.

Applicant Delay

A reply to a Notice to File Missing Parts was due on or before July 19, 2002 (the date that is three months after April 19, 2002, the date on which the Notice to File Missing Parts was mailed). Patentee filed a response to the Notice to File Missing Parts on September 24, 2002, thereby according an Applicant Delay of 67 days. Patentee does not dispute the PTO’s calculation for this Applicant Delay from July 20, 2002 (the day after the date that is three months after the date on which the Notice to File Missing Parts was mailed), to September 24, 2002. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before December 8, 2004 (the date that is three months after September 8, 2004, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on February 8, 2005, thereby according an Applicant Delay of 62 days. Patentee does not dispute the PTO’s calculation for this Applicant Delay from December 9, 2004 (the day after the date that is three months after the date on which the Office Action was mailed), to February 8, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before September 9, 2005 (the date that is three months after June 9, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on October 11, 2005, thereby according an Applicant Delay of 32 days. Patentee does not dispute the PTO’s calculation for this Applicant Delay from

September 10, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to October 11, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before March 21, 2006 (the date that is three months after December 21, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action (an RCE) on June 16, 2006, thereby according an Applicant Delay of 87 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 22, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to June 16, 2006. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before January 2, 2007 (the date that is three months after October 2, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 2, 2007, thereby according an Applicant Delay of 59 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from January 3, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to March 2, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before August 17, 2007 (the date that is three months after May 17, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on October 31, 2007, thereby according an Applicant Delay of 75 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from August 18, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to October 31, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before March 12, 2008 (the date that is three months after December 12, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 12, 2008, thereby according an Applicant Delay of 92 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 13, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to June 12, 2008. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 474 days (i.e., the sum of 67 days, 62 days, 32 days, 87 days, 59 days, 75 days, and 92 days)

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 27 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 974 days (i.e., the sum of 501 days of "A Delay" and 474 days of "B Delay" minus the 1 day of overlap);
- 2) Total Applicant Delay should be calculated as 474 days; and
- 3) Total PTA should be calculated as 500 days.


This patent is not subject to a terminal disclaimer.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 16113-117701.

Respectfully submitted,

Date: _____

2/2/09


John-Paul Fryckman
Reg. No. 62,880

Fish & Richardson P.C.
Customer Number 26192
Telephone: (858) 678-5070
Facsimile: (877) 769-7945